RECEIVED
CENTRAL FAX CENTER

DEC 1 3 2006

Atty. Docket No. 016072-000600US

PTO FAX NO.: 1-571-273-8300

ATTENTION: Office of Petitions

Group Art Unit 1761

OFFICIAL COMMUNICATION

TO THE ATTENTION OF

OFFICE OF PETITIONS

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the following document in re Application of Peter Rudloff, Application No. 09/403,174 filed October 18, 1999 for "System and Method for Identifying and Authenticating Accessories, Auxiliary and/or Operating Substances for Items of Equipment", is being facsimile-transmitted to the Patent and Trademark Office on the date shown below.

Documents Attached

1. Appellant's Substitute Appeal Brief Pursuant to 37 CFR §1.192(a) and Pursuant to Decision on a Petition

Number of pages being transmitted, including this page: 15

Dated: December 13, 2006

Jane Welch

PLEASE CONFIRM RECEIPT OF THIS PAPER BY RETURN FACSIMILE AT (415) 576-0300

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, CA 94111-3834
Telephone: 415-576-0200
Fax: 415-576-0300
0012

60938500 v1

RECEIVED
CENTRAL FAX CENTER
DEC 13 2006

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300, on December 13, 2006.

By _____
Jane Welch

PATENT

Attorney Docket No. 16072-6
Client Ref. No. S 1098 - W/cd

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

PETER RUDLOFF

Application No. 09/403,174

Filed: October 18, 1999

For: SYSTEM AND METHOD FOR IDENTIFYING AND AUTHENTICATING ACCESSORIES, AUXILIARY AGENTS AND/OR FUELS FOR TECHNICAL APPARATUS

Confirmation No. 3109

Examiner: Drew E. Becker

Technology Center/Art Unit: 1761

APPELLANT'S
SUBSTITUTE APPEAL BRIEF
PURSUANT TO 37 CFR §1.192(a)
AND PURSUANT TO
DECISION ON A PETITION

San Francisco, CA 94111
December 13, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

This Substitute Appeal Brief ("Brief") is filed in response to the Decision dated October 16, 2006 which denied appellant's Petition for revival of the application for unintentional abandonment dated February 16, 2006. The Decision required the filing of a substitute brief which contains a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters.

This Brief is in full compliance with all requirements of 37 CFR §1.192, including, specifically, subsections (c)(5) pertaining to the concise explanation of the claimed invention, now covered by 37 CFR §41.37(c)(1)(v).

REAL PARTY IN INTEREST:

The real party in interest of the subject application is SCIL ANIMAL CARE COMPANY GMBH, the assignee of the present application.

RELATED APPEALS AND INTERFERENCES:

There are no related appeals and interferences.

STATUS OF CLAIMS:

Claims 14-22, 25 and 26 stand finally rejected.

STATUS OF AMENDMENTS:

An Amendment and Request for Reconsideration After Final under 37 CFR §1.116 was filed via facsimile on September 30, 2003. The Amendment was entered, but the Examiner indicated that it did not place the application in condition for allowance.

CONCISE EXPLANATION OF THE CLAIMED INVENTION:

The present invention is directed to marking for accessories and auxiliary or operating substances or their storage containers, as well as an identification system, that allow a clear identification or authorization by the manufacturer of an item of the equipment and that prevent the proliferation of unauthorized accessories or unauthorized auxiliary or operating substances.

As is set forth in system claim 25, the operation of an item of equipment (10), shown in Fig. 1, is controlled by identifying and authenticating a substance (14) handled by the item of equipment. The system has first machine-readable information (32, 32', 32", 34, 34', 34", 36, 36', 36") in a first region of the data carrier portion (18) (Fig. 2) concerning the substance (14) and second information (26), for example in the form of the letters SCIC shown in Fig. 2, that can be detected by a human eye and is distinctive to a human viewer.

These first and second informations are applied to the substance or to the container (16) for the substance. A reading and evaluating device (20) shown in Fig. 1 is adapted to read the first information and the second information, and authorizing information for the substance is stored in a memory (44). The evaluating device compares the read second information with the authorizing information that is stored in the memory. The evaluating device (20) enables the operation of the item of equipment (10) when the read second information (26) coincides with the stored authorizing information by generating an enabling signal that permits the item of equipment (10) to operate. When the read second information does not coincide with the stored authorizing information, the item of equipment is not enabled and it cannot operate. (Paragraph 30, page 8, lines 14-17.)

Independent claim 26 covers the corresponding method of the invention. It requires controlling the operation of an item of equipment (10) that handles a substance (14) by applying first information (32, 32', 32", 34, 34', 34", 36, 36', 36") which is dependent on the substance (14) and is machine-readable (Paragraph 25, page 6, lines 24-26) to a first region (18) associated with the substance. (Paragraph 07, page 3, lines 19-21). Second information which is detectable by a human eye and distinctive to a human viewer is applied to a second region (26) associated with a substance. (Paragraph 29, page 7, lines 18-24). An information sample which corresponds to the second information is stored (Paragraph 30, page 8, lines 7-9), and the machine-readable first information present at the first region is read and decoded. (Paragraph 30, page 7, line 29 to page 8, line 7). The second information present at the second region (26) is compared to the read second information of the second region with the stored information sample, and a signal is generated when the read second information coincides with the stored information sample to permit operation of the item of equipment (10), while preventing its

operation when the read second information does not coincide with the stored information sample. (Paragraphs 31 and 32, page 8, lines 26-30, and page 8, line 31 to page 9, line 2).

More generally, the provision of the information that may be detected by the human eye and is distinctive to a human viewer on the accessories or the auxiliary or operating substances (14) or their storage containers (16) and of the reading and evaluating device (20) for this information on the item of equipment makes it possible for the equipment to inspect, preferably likewise visually, whether the information provided on the data carrier portion coincides with a prescribed item of information stored in the equipment, so that operation of an item of equipment is made possible only if they coincide. (Paragraph 32, page 8, line 31 to page 9, line). This authentication function of the system according to the present invention is supplemented by the detectability of information by the human eye and by its property of being distinctive to a human viewer directly, that is to say, without prolonged viewing. Consequently, the user may initially check with his own eyes whether the accessories or auxiliary or operating substances are products authorized by the manufacturer. (Paragraph 05, page 2, lines 18-26).

Thus, the present invention provides a system for controlling the operation of an item of equipment by identifying and authenticating a substance handled by the item of equipment, where the system includes first machine-readable information concerning the substance and second information that may be detected by a human eye and is distinctive to a human viewer. The first and second informations are applied to the substance or to the container for the substance. The system further includes a reading device that is adapted to read the first information and the second information, a memory that stores authorizing information for the substance, and an evaluating device that compares read second information with the authorizing information stored in the memory. The evaluating device enables the operation of the item of equipment when the read second information coincides with the stored authorizing information by generating an enabling signal permitting operation of the item of equipment. The evaluating device does not enable the operation of the item of equipment when the read second information does not coincide with the stored authorizing information.

The present invention also provides a method for controlling the operation of an item of equipment that handles a substance. The method includes applying first information that

is dependent on the substance and is machine-readable to a first region associated with the substance, applying second information that is detectable by a human eye and distinctive to a human viewer to a second region associated with a substance, storing an information sample that corresponds to the second information, reading and decoding the machine-readable first information present at the first region, reading the second information present at the second region, comparing the read second information of the second region with the stored information sample, generating a signal when the read second information coincides with the stored information sample that permits operation of the item of equipment, and preventing the operation of the item of equipment when the read second information does not coincide with the stored information sample.

ISSUES:

Are claims 14-16, 18, 20-21 and 25-26 anticipated by Moed et al. (U.S. Patent No. 5,770,841)?

Are claims 17 and 19 obvious in view of Moed et al.?

Is claim 22 obvious in view of Moed et al. in view of Kubo (U.S. Patent No. 5,422,470)?

GROUPING OF THE CLAIMS:

Claims 25 and 26 are independent claims. The remaining claims depend, either directly or indirectly, on claim 25 and are directed to other novel features of the present invention. However, for purposes of this appeal, claims 14-18 and 20-22 can stand or fall with claim 25.

ARGUMENT:

Independent claims 25 and 26 are directed to a system and a method, respectively, for controlling the operation of equipment, such as machinery processing a substance or product which is typically inside a container. The container (or substance) carries two types of information, substance or product identifying information, referred to as "first information" in the claims, which is product-dependent, such as technical data concerning the product, and manufacturer-dependent information, such as a trademark, referred to as "second information" in

the claims, which can be the same for some or all products for a given manufacturer, for example. The second information "can be detected by a human eye and is distinctive to a human viewer" (claim 25, method claim 26 using virtually identical language but employing method terminology).

Independent claims 25 and 26, as well as dependent claims 14-16, 18 and 20-21, were finally rejected for anticipation by Moed (U.S. Patent No. 5,770,841) in the Office Action mailed June 12, 2003.

The anticipation rejection of claims 25 and 26 over Moed holds, amongst other things, that "if the read information does not coincide with the stored information ... operation of the item of equipment [is disabled] (i.e., when the system is unable to verify a decoded destination address by reference to the U.S. postal service's Zip+4 for the package, the system *disables the normal continuing the packaging processing* by displaying the destination address image on the workstation, therefore, an operator can review and make a manual correction)". (Final Rejection, page 3, last paragraph, italics added).

In contrast to Moed, the present invention provides, and independent claims 25 and 26 require, that information corresponding to the second (visible) information is stored in a memory and includes "an evaluating device for comparing read second information with the authorizing information stored in the memory, the evaluating device enabling the operation of the item of equipment when the read second information coincides with the stored authorizing information by generating an enabling signal permitting operation of the item of equipment, *and not enabling the operation of the item of equipment when the read second information does not coincide with the stored authorizing information*" (claim 25). Method claim 26 is similarly limited and requires amongst others "comparing the read second information of the second region with the stored information sample, generating a signal when the read second information coincides with the stored information sample which permits operation of the item of equipment, *and preventing the operation of the item of equipment when the read second information does not coincide with the stored information sample*".

Thus, the product or substance subject to control carries information which can be viewed and interpreted by the human eye, and this information is checked against corresponding

information stored in memory. If the two coincide, e.g. are the same, the equipment subject to control is permitted to operate. If, however, there is a discrepancy between the read and stored information, *the operation of the equipment under control is interrupted.*

It is respectfully submitted that Moed teaches, and Fig. 4 thereof illustrates, that the OCR processed destination address on a package or a letter is validated or verified at step 424 (Fig. 4) by attempting to match it with an address in the Zip+4 database, which has an exhaustive list of valid U.S. addresses. (Column 13, lines 24-28). If the decoded destination address does not match a valid Zip+4 database address, the system attempts to automatically correct the wrong address at step 430. (Column 13, lines 41-44).

If the attempt to automatically correct the address fails, the incorrect destination address and the closest possible addresses from the database are displayed (step 508, Fig. 5) and "At step 510 .... [t]he operator manually enters the correct destination address by selecting the correct address from the closest possible matches ...." (Column 14, lines 40-44). If the operator selected an address from the Zip+4 database, the selected address is validated and the verification ends. If, however, the destination address was typed by the operator, the address is validated at step 516, which

> determines whether the keyed in address matches a valid address from the database. If not, the method also attempts to correct common key entry mistakes in order to see if the corrected key entered data matches one of the addresses from the database .... The correction can be carried out by attempting to match a valid address from any address in the ZIP+4 database, or by trying to match one of the few close addresses transferred to the image display workstation from the label decoding system.
>
> After the manually entered destination address data is validated, the method proceeds to step 514 and returns the correct destination address to the image server 29, which returns the data to the label decoding system 14. The method 500 then terminates at step 518.

The Moed patent provides no information at all what happens in the event the operator cannot find a match for the address in the Zip+4 database. The operator is on his own in such a situation and finds no guidance whatsoever in Moed what he could or should do next.

Moed teaches that the operator of the device can attempt to conform the address in question to a ZIP+4 address as shown in Fig. 5. In the system of the present invention, this is not possible. The present invention does not seek to conform the "second information" (e.g. a trademark) on the product to the second information stored in memory. Quite to the contrary, the present invention seeks to find out if the two coincide. If they do, the process or system is permitted to continue operating. If they don't, the system is deactivated but no attempt is made to "correct" the second information on the product and/or in the memory.

Contrary to the statement in the last paragraph on page 3 of the final rejection that "an operator can review and make a manual correction" in his attempt to match the destination address to a Zip+4 database address, Moed does not teach what he can or should do when the operator's attempt is unsuccessful.

However, this is precisely the point where the present invention provides a solution. If the read and stored second information (e.g. trademark) do not match, claim 25 requires:

> ... and <u>not enabling the operation of the item of equipment</u> when the read second information does not coincide with the stored authorizing information.

Similarly, claim 26 requires:

> ... and <u>preventing the operation of the item of equipment</u> when the read second information does not coincide with the stored information sample.

As the foregoing demonstrates, Moed teaches how to *correct* an address so it matches a ZIP+4 address. Moed does not say what to do when the two cannot be matched.

The present invention, as defined by claims 25 and 26, has no interest in *correcting or changing* the second information on the product and/or in memory. It is only interested in whether or not the two match. If they do not, the machinery is disabled.

Since Moed contains no disclosure whatsoever about disabling or preventing the operation of machinery if the read and stored second information on the product and in memory do not match, Moed does not anticipate the claims.

Furthermore, appellant strongly disagrees, as already mentioned above, that verifying that the destination address corresponds to a ZIP+4 address and displaying destination addresses on the workstation so that the operator can manually correct discrepancies is the same or analogous to disabling machinery in accordance with the present invention when the read and stored second information do not match. When the destination address is displayed at Moed's workstation, the operator performs an address checking and correcting function. In the present invention, the second information, which is analogous to Moed's destination address, is also checked, but it is not corrected when there is no match. Instead, the non-match is used for "*not enabling the operation of the item of equipment when the read second information does not coincide with the stored authorizing information*" (claim 25).

Moed contains no suggestion, teaching or disclosure to use its address checking and correcting system for controlling, i.e. selectively disabling, attached machinery. No machinery is attached to and/or controlled by the address checking system of Moed.

Furthermore, appellant also disagrees with the observation on page 7 of the final rejection that:

> "The claimed limitations includes
>
> '*a memory storing authorizing information for the substance*' (in claim 25);
>
> '*storing an information sample which corresponds to the second information*' (in claim 26); and
>
> the read second information is compared with the stored data.

Therefore, Moed clearly teaches the address scanned is compared with an address in the U S postal Service's zip code +4 database. Therefore, given a broadest interpretation of the claim, Moed anticipates the claimed limitation (see the discussion above)".

Although claims 25 and 26 recite a memory and storing an information sample and that the read second information is compared with the stored data, this is not the end of the claim.

As discussed in detail above, claims 25 and 26 additionally require disabling the machinery when the read and stored second information (destination address and ZIP+4 code in Moed) do not match. Reading and comparing the read information to the stored information and *correcting* one of them when there is a mismatch, as is done by Moed, is also not the same as *reading and comparing* the read and stored information and not correcting either but, instead, *disabling* a piece of machinery when there is no match, as is recited in claims 25 and 26.

Accordingly, it is respectfully submitted that Moed does not anticipate claims 25 and 26.

CONCLUSION

In view of the above Argument, appellant requests reversal of the anticipation rejection of independent claims 25 and 26.

Since the dependent claims all contain the same limitations by virtue of their dependencies from the independent claims, the dependent claims are also not anticipated for at least the reasons claims 25 and 26 are not anticipated.

Please deduct the requisite fee, pursuant to 37 CFR § 1.17(c), of $165.00 from deposit account 20-1430 and any additional fees associated with this Brief. This Brief is submitted in triplicate.

Respectfully submitted,

Babak Kusha
Reg. No. 51,095

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
(415) 576-0200
Fax (415) 576-0300
KTL/llc

Claims Appendix

14. A system according to claim 25, wherein

- the substance or its storage container includes a data carrier portion where the second information is stored, and wherein
- the evaluating device comprises
  - a comparator for comparing the read second information with the stored authorizing information, and
  - an enabling controller for at least one functional component of the item of equipment.

15. A system according to claim 14, wherein the data carrier portion has a first region where only the first information is stored, and a second region where the second information is stored.

16. A system according to claim 14, including at least one reference marking at the data carrier portion for orienting the reading device.

17. A system according to claim 15, wherein

- the first information stored at the first region of the data carrier portion is formed by a machine-readable code, and
- wherein the second information stored at the second region of the data carrier portion is formed by a trademark.

18. A system according to claim 15, wherein

- the first region of the data carrier portion has a multiplicity of lines of a binary pixel code, the binary pixel code containing the first machine-readable information, and
- wherein the second region of the data carrier portion has a plurality of lines of a pixel code which together form the second information.

19. A system according to claim 15, including a machine-readable limit marking comprising at least one blank line provided between the first region of the data carrier portion and the second region of the data carrier portion.

20. A system according to claim 16, wherein the reference marking has a frame extending around at least one of the first and second regions of the data carrier portion.

21. A system according to claim 18, wherein the binary pixel code of at least one of the lines has a row of adjacently lying bit markings of a binary representation of an item of information.

22. A system according to claim 21, including binary bit markings for a check digit for the binary representation of the information in each line.

Claims 23-24 (canceled)

25. A system for controlling the operation of an item of equipment by identifying and authenticating a substance handled by the item of equipment, the system comprising first machine-readable information concerning the substance and second information that can be detected by a human eye and is distinctive to a human viewer, the first and second informations being applied to the substance or to the container for the substance, a reading device adapted to read the first information and the second information, a memory storing authorizing information for the substance, and an evaluating device for comparing read second information with the authorizing information stored in the memory, the evaluating device enabling the operation of the item of equipment when the read second information coincides with the stored authorizing information by generating an enabling signal permitting operation of the item of equipment, and not enabling the operation of the item of equipment when the read second information does not coincide with the stored authorizing information.

26. A method for controlling the operation of an item of equipment that handles a substance comprising applying first information which is dependent on the substance and is machine-readable to a first region associated with the substance, applying second information which is detectable by a human eye and distinctive to a human viewer to a second

region associated with a substance, storing an information sample which corresponds to the second information, reading and decoding the machine-readable first information present at the first region, reading the second information present at the second region, comparing the read second information of the second region with the stored information sample, generating a signal when the read second information coincides with the stored information sample which permits operation of the item of equipment, and preventing the operation of the item of equipment when the read second information does not coincide with the stored information sample.

60920535 v1